

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK INDERBITZEN, KIRK JOHNSON, and SUSANA MARTINEZ

Appeal No. 1999-0701
Application No. 08/705,005

HEARD: October 26, 2000

Before CALVERT, FRANKFORT, and JENNIFER D. BAHR,
Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 through 5 and 7 through 30, which are all of the claims remaining in this application. Claims 2 and

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6 have been canceled.

Appellants' invention relates to a dilation catheter for percutaneous transluminal coronary angioplasty procedures (PTCA), and more particularly to dilation catheters for use in PTCA procedures wherein blood is perfused distally of the dilation balloon during the inflation cycle of the balloon, as well as to a method for converting a standard dilation balloon to a perfusion balloon. Independent claims 1, 11, 16 and 23 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:¹

¹As indicated in Paper No. 28, mailed August 19, 1998, the examiner's listing of the Gurbel et al. patent on page 3 of the examiner's answer was in error and this patent is not being relied upon for rejecting the claims before us on appeal. Likewise, we note that the examiner's listing of claims "1-5" on page 4 of the answer as being rejected on Blackshear is in error. Claim 2 has been canceled and claims 3 and 4 stand rejected under 35 U.S.C. § 103 as unpatentable over Blackshear in view of Sahota. It appears that the

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Sahota	5,019,042	May 28,
1991		
Blackshear, Jr. et al.	5,308,356	May 3,
1994		
(Blackshear)		(filed Feb. 25, 1993)

Claims 1, 5, 7, 8, 10, 16 through 18, 20, 22, 23 and 27 through 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Blackshear.

Claims 3, 4, 9, 11 through 15, 19, 21 and 24 through 26 stand rejected under 35 U.S.C. § 103 as unpatentable over Blackshear in view of Sahota.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the final rejection (Paper

listing of claims 1-5 is a typographical error, meant to be claims --- 1, 5 ---.

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No. 22, mailed August 4, 1997) and the examiner's answer (Paper No. 25, mailed March 16, 1998) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 24, filed November 12, 1997) and reply brief (Paper No. 26, filed May 20, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that neither of the examiner's rejections will be sustained. Our reasons follow.

Looking first to the examiner's rejection of claims 1, 5, 7, 8, 10, 16 through 18, 20, 22, 23 and 27 through 30 under 35 U.S.C. § 102(e) as being anticipated by Blackshear, we note

our agreement with appellants' arguments in the brief (pages 8-11) that the Blackshear patent does not describe, teach or suggest a perfusion dilation catheter wherein a perfusion brace is disposed around the balloon of the catheter "independently of and in substantially non-compressive relationship to the exterior surface of said balloon when said balloon is in its collapsed state," as required, in the same or similar language, in each of the independent claims on appeal. In this regard, we understand the claim language "substantially non-compressive relationship," in light of appellants' specification (page 8, lines 14-19), as meaning that the exterior surface of the balloon in its collapsed condition "is not substantially constrained by the spiral member 38 of the brace" seen in Figures 1-4 or the brace seen in Figures 7-9 and that the exterior surface of the balloon in its collapsed state is typically "spaced radially inwardly at least along portions of the brace."

The band (28) of Blackshear which defines the perfusion channel therein is disclosed (col. 7, lines 37-53) as being

"helically wound around the outer surface 34 of the balloon member 16" and as having distal and proximal wraps (30, 32) for securing the ends of the band to the tubular member (14). The band is further described in column 10, lines 9-26, as being made of an elastomer. While we can agree with the examiner that the band (28) of Blackshear may be considered to be disposed about the balloon independently of the exterior surface of the balloon, in the sense that it is not connected to the exterior surface of the balloon, we fail to find any basis on which to conclude that appellants' claimed feature of a "substantially non-compressive relationship" between the exterior surface of the balloon and the wrapped elastomer band, as we have interpreted that language above, would be inherent in the structure of Blackshear's perfusion dilation catheter, as the examiner has urged in both the final rejection and answer. Having the elastomeric band (28) of Blackshear wrapped around the outer surface (34) of the balloon in its collapsed state, in our view, would place the band in contact with the outer surface of the balloon over its entire length and provide no areas or portions where the outer

surface of the balloon would be spaced radially inwardly at least along portions of the band (perfusion brace), as required in the claims on appeal. For this reason alone we will not sustain the examiner's rejection of independent claims 1, 16 and 23 on appeal under 35 U.S.C. § 102(e) based on Blackshear, or the rejection of claims 5, 7, 8, 10 and 27 which depend from claim 1, claims 17, 18, 20, 22 and 28 which depend from claim 16, or claims 29 and 30 which depend from claim 23 on that same statutory basis.

In addition, we will also not sustain the examiner's rejection of claims 3, 4, 9, 11 through 15, 19, 21 and 24 through 26 under 35 U.S.C. § 103 as unpatentable over Blackshear in view of Sahota. Given the examiner's total lack of any comments or explanation in the examiner's answer with regard to this rejection and the examiner's somewhat anomalous and cryptic position as set forth on page 3 of the final rejection (Paper No. 22), we are at a complete loss to understand exactly what teachings the examiner is relying on from Sahota and exactly how the examiner intends to modify the

perfusion dilation catheter of Blackshear based on Sahota.
Our own review of the applied references reveals nothing which would have led one of ordinary skill in the art to modify the perfusion catheter of Blackshear based on the catheter in Sahota so as to result in the subject matter set forth in appellants' claims on appeal.

As for the examiner's position that the requirement in claim 3 on appeal "would be inherent and obvious" (final rejection, page 3), we see no basis in Blackshear to support any such position and are in agreement with appellants' argument on page 11 of their brief. Regarding independent claim 11 and the claims which depend therefrom, we share appellants' view as set forth on page 12 of their brief that there is nothing in Blackshear or Sahota which would have been suggestive to one of ordinary skill in the art of a perfusion brace as defined in claim 11 that is "slidable onto a collapsed dilation balloon of a catheter to transform the catheter into a perfusion balloon catheter." Like appellants (brief, page 12), we also see no basis in the applied

references or otherwise for concluding that the "barb" set forth in claim 21 on appeal would have been obvious to one of ordinary skill in the art at the time of appellants' invention. With further regard to claims 4 and 9 which depend from claim 1, claim 19 which ultimately depends from claim 16 and claims 24 through 26 which depend from claim 23, we observe that there is nothing in Sahota which provides for that which we have discussed above as lacking in Blackshear as applied against the respective independent claims.

To summarize our decision, we again note that the examiner's rejection of claims 1, 5, 7, 8, 10, 16 through 18, 20, 22, 23 and 27 through 30 under 35 U.S.C. § 102(e) as being anticipated by Blackshear has not been sustained, and that the rejection of claims 3, 4, 9, 11 through 15, 19, 21 and 24 through 26 under 35 U.S.C. § 103 as being unpatentable over Blackshear in view of Sahota has also not been sustained.

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Accordingly, the decision of the examiner rejecting
claims 1, 3 through 5 and 7 through 30 on appeal is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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